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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/476,415

12/30/1999

DALE SANDBERG

3855.29

7821

21999

7590

03/28/2008

KIRTON AND MCCONKIE

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EXAMINER

ALTSCHUL, AMBER L

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

03/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/476,415	<b>Applicant(s)</b> SANDBERG, DALE	
	<b>Examiner</b> AMBER L. ALTSCHUL	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-29,32 and 42-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 30-31, and 33-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29,32 and 42-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 29, 2008 has been entered.

***Notice to Applicant***

2. This communication is in response to the amendment filed on February 29, 2008. Claims 21-29, 32, 42-55 remain pending. Claims 21-28, 32, and 42-43 have been amended. Claims 44-55 are new.

***Claim Objections***

3. Claim 54 and 55 are objected to because of the following informalities: Claims 54 and 55 depend from improper claim numbers. Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 44-47 are rejected under 35 U.S.C. 102(b) as being unpatentable over United States Patent Number US 5,072,383, Brimm, et al., hereinafter Brimm.

6. (New) As per claim 44, Brimm teaches a method for creating a form for use by a specialized healthcare provider, comprising:

selecting the specialized healthcare provider, (column 7, lines 36-42);

determining a first pool of healthcare procedures characteristically rendered by the specialized healthcare provider, (column 8, lines 20-34);

determining a second pool of healthcare diagnoses characteristically employed by the specialized healthcare provider, (column 8, lines 35-55);

generating the form wherein the form comprises the first pool and the second pool of healthcare procedures and diagnoses characteristically performed and employed by the specialized healthcare provider, (column 8, lines 56-64);

wherein the specialized healthcare provider employs the form to record healthcare service information of a patient as part of the healthcare services provided to the patient, (column 9, lines 1-6).

8. (New) As per claim 45, Brimm teaches the method of claim 44 as described above.

Brimm further teaches wherein the specialized healthcare provider employs the form by selecting at least one of (i) a diagnosis of the form and (ii) a procedure of the form in association with the specialized healthcare provider rendering one of the procedures from the first pool of healthcare procedures on the patient, (column 10, lines 10-15 and column 11, lines 26-49).

9. (New) As per claim 46, Brimm teaches the method of claims 44-45 as described above.

Brimm further teaches wherein a computer interface is used to generate the form, (column 5, lines 59-64).

10. (New) As per claim 47, Brimm teaches the method of claims 44-46 as described above.

Brimm further teaches wherein a user further performs the steps of:

selecting a number of rows for inclusion into the form, (column 5, lines 59-64);  
defining specifications relating to the first pool of healthcare procedures  
characteristically performed by the specialized healthcare provider, (column 9, lines 42-53);  
defining specifications relating to the second pool of healthcare diagnoses  
characteristically employed by the specialized healthcare provider, (column 11, lines 56-66);  
displaying a reference to the form in a searchable field within a form definition window,  
(column 8, lines 48-55 and column 10, lines 10-15);  
populating one or more fields of the form definition window, (column 10, lines 10-15);  
displaying the form definition window with the populated fields, (column 6, lines 63-68  
and column 7, lines 1- 10);  
entering procedure and diagnostic codes adapted to the practice of the specialized  
healthcare provider, (column 8, lines 20-34); and  
displaying a preview of the form, (column 13, lines 14-19).

11. Claims 49-52 repeat the limitations of claims 44-47, and are therefore rejected for the same reasons as those claims.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 21-29, 32, 42-43, and 44-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221), Lavin et al. (5,772,585), Provost et al. (6,341,265), and Lancelot et al. (6,434,531).

(A) As per claims 21-22, 24-25, and 32, Evans discloses a medical records method and system for storage and retrieval of dynamic electronic medical records in a computer environment, such as a local or wide area network including portable computers (col. 1 lines 5-10), wherein patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, are captured at the point of care of a patient in real-time, such as during an examination or in hospital (see Figure 24), using a graphical user interface having touch screens in a point of care system (Abstract; lines 1-5; col. 2 lines 20-64, col. 5 lines 29-55, and col. 5 lines 8-10), comprising:

(a) selecting a procedure from a list of procedures administered by a physician of a healthcare facility, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(b) selecting a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(c) activating the form for use by a health care provider when diagnosing and performing a procedure or administering a treatment on a patient (Figures 1,5-6, 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(d) determining a particular sequence of the pool of healthcare procedures based upon user preferences (Figure 20, the doctor can select the sequence of the procedures displayed on the form);

(e) using the form to select a procedure, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64) and to select a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64).

Evans fails to expressly recite a “customizable form”.

Feldon discloses entering a patient’s demographic information, medical history, prescribed medication and other relevant information for a patient, including information a physician documents during the exam using exam descriptors, into data entry forms, wherein a user is able to customize these data entry forms by editing existing forms or by redesigning completely new forms, wherein the form is able to be saved using a computer (Figure 1, col. 4 lines 13-63, col. 8 lines 62-67, and col. 9 lines 15-65, col. 11 lines 1-58, and col. 12 lines 1-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned features of Feldon within the method of Evans with the motivation of allowing forms to be generated based on the user’s needs and customized for the particular task at hand (Feldon; col. 4 lines 52-54) and transforming a patient chart from a static record of a few clinical interactions into a dynamic, real-time comprehensive record (Evans; col. 2 lines 34-40).

Evans and Feldon fail to expressly disclose patients wherein the step for generating the customizable form comprises: defining display specifications that relate to i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference.

Lavin discloses creating a customized list for a health care provider's practice specialty, wherein the customized list relates to diagnoses and procedures used in the specialty (reads on "a display of the healthcare procedures characteristically performed by the particular healthcare provider" and "a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference") (Figure 13, col. 9 lines 29-40). Further, Lavin discloses creating and viewing the customized list in a graphical user interface (reads on "customizable form") (Fig. 17, col. 3 line 65 to col. 4 line 17, col. 13 lines 28-59).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lavin within the method taught collectively by Evans and Feldon with the motivation of maximizing the efficiency and effective use of the physician's time (col. 15 lines 46-59) by providing customized lists created for a particular physician's practice specialty (Fig. 13).

Evans, Feldon, and Lavin fail to expressly disclose using the customizable form to display billing information prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient, and wherein the step for



using the customizable to display billing information is performed during an examination of the patient, and wherein the step for using the customizable form to display billing information includes allowing the healthcare provider to selectively adjust the cost of rendering the one of the procedures at the time of the examination of the patient.

Provost discloses a claim form for entering patient information, including insurance plan information, diagnosis codes, treatment codes, wherein the dollar amounts for a treatment code are displayed, wherein the dollar amounts can be displayed in a short amount of time which is limited by data transmission rates, wherein the patient is able to present because the dollar amounts can be collected from the patient in the office, wherein the physician may provide alternative treatments which are approved for payment by an insurance plan (Abstract, Fig. 3, 4A, 4B, col. 8 line 32 to col. 12 line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught collectively by Evans, Feldon, and Lavin with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57) and decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57).

Evans, Feldon, Lavin, and Provost fails to expressly disclose:

using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses, and displaying the customizable form in a definition window.

Lancelot discloses using a computer interface to define a new structure for the customizable form that is not generated from a printed data form (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6), selecting a number of rows for inclusion into the customizable form (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6), defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses (Fig. 4, 6 col. 10 lines 14-21, col. 15 line 35 to col. 16 line 6), and displaying the customizable form in a definition window (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lancelot within the method taught collectively by Evans, Feldon, Lavin, and Provost with the motivation of allowing for the tailoring of templates (or forms) based on the requirements for a given patient (Lancelot; col. 1 lines 53-60).

(B) As per claim 23, Evans discloses a data interface permitting communication with external sources to obtain patient data and to transfer patient information to external health care providers, such as demographic data, laboratory test results, x-ray images, ICD9 diagnosis codes and CPT procedure codes, prescriptions for medications (col. 9 lines 1-14). The remainder of claim 23 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21, and incorporated herein. It is noted that the step of transferring patient information, including ICD9 diagnosis codes and CPT procedure codes, to external health care providers (col. 9 lines 1-14) is considered to be a form of “one or more other healthcare procedures or diagnoses used by another healthcare provider of a healthcare facility” as recited in claim 23.

(C) As per claim 26, Feldon discloses customizing data entry forms for a physician, for example for an examination of the eye by defining common types of eye exams (col. 1 line 20 to col. 2 line 12 and col. 4 lines 30-45). The remainder of claim 26 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21, and incorporated herein. The motivation for combining Feldon within Evans is given above in claim 21, and is incorporated herein.

(D) As per claim 27-29, Evans discloses entering and updating a patient record using a form, wherein the patient record includes insurance information, ICD9 diagnosis codes and CPT procedure codes, wherein upon entering and updating information, the electronic medical record system filed the patient's record in real-time in the patient data repository (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14).

It is noted that Evan's discloses recording insurance information as well as diagnosis and procedure codes within a patient record as discussed above (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14). As this information is most frequently used for billing purposes (i.e., billing insurance companies), it is respectfully submitted that this information within the patient record is a form of a "billing record." Furthermore, as per the recitation of "the billing record corresponding to standards in the industry," it is noted that ICD9 codes and CPT codes are widely accepted codes used to report and index medical records and are considered to be the standard codes set for reporting health care services in electronic data transactions.

(E) Claims 42-43 repeat the limitations of claims 21 and 33, and are therefore rejected for the same reasons as those claims.

14. Claims 44-55 are rejected under 35 U.S.C. 103 as being unpatentable over United States Patent Number US 5,072,383, Brimm, et al., hereinafter Brimm in view of Provost et al. (6,341,265).

15. (New) As per claim 48, Brimm teaches the method of claims 44-47 as described above. Brimm does not teach wherein the form displays billing information on a real time basis and prior to the rendering of the one of the procedures on the patient to allow the specialized healthcare provider to inform and advise the patient as to available healthcare services that may be rendered, including the most cost efficient healthcare alternative for the patient. However, Provost teaches wherein the form displays billing information on a real time basis and prior to the rendering of the one of the procedures on the patient to allow the specialized healthcare provider to inform and advise the patient as to available healthcare services that may be rendered, including the most cost efficient healthcare alternative for the patient, (Abstract, Fig. 3, 4A, 4B, column 8, lines 32 to col. 12, line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught by Brimm with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57), decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57), and improving efficiency (Provost; column 2, lines 49-51).

16. (New) As per claim 53, Brimm teaches the method of claims 44-48 as described above. Brimm does not teach wherein the form is used to automatically create an accurate billing record statement for the patient. However, Provost teaches wherein the form is used to automatically

create an accurate billing record statement for the patient, (Abstract, Fig. 3, 4A, 4B, column 8, lines 32 to col. 12, line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught by Brimm with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57), decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57), and improving efficiency (Provost; column 2, lines 49-51).

17. (New) As per claim 54, Brimm does not teach wherein the accurate billing record statement is created in real time. However, Provost teaches wherein the accurate billing record statement is created in real time, (Abstract, Fig. 3, 4A, 4B, column 8, lines 32 to col. 12, line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught by Brimm with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57), decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57), and improving efficiency (Provost; column 2, lines 49-51).

18. (New) As per claim 55, Brimm does not teach wherein the accurate billing record statement corresponds to standards established in the industry. However, Provost teaches wherein the accurate billing record statement corresponds to standards established in the industry, (Abstract, Fig. 3, 4A, 4B, column 8, lines 32 to col. 12, line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught by Brimm with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57), decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57), and improving efficiency (Provost; column 2, lines 49-51).

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 21-29, 32, 42-55 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches Method and apparatus for reporting emergency incidents (US 6594634 B1), Automatic report generating system (US 6055541 A), Method for automated collection of psychotherapy patient information and generating reports and treatment plans (US 6338039 B1), Knowledge-based expert interactive system for pain (US 5908383 A), Collapsible flowsheet for displaying patient information in an electronic medical record (US 5950168 A), Method of managing and controlling access to personal information (US 6073106 A), System for and method of collecting and populating a database with physician/patient data for processing to improve practice quality and healthcare delivery (US 6151581 A), Systems, methods and computer program products for guiding the selection of therapeutic treatment regimens (US 6081786 A).

***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber L. Altschul whose telephone number is 571-270-1362. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALA  
March 25, 2008

/Robert Morgan/  
Primary Examiner, Art Unit 3626

